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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,166	07/25/2003	Charles E. Price	946478.263692	2507
24239 7590 09/26/2007 MOORE & VAN ALLEN PLLC P.O. BOX 13706 Research Triangle Park, NC 27709			EXAMINER MARCANTONI, PAUL D	
			ART UNIT 1755	PAPER NUMBER
			MAIL DATE 09/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/627,166	Applicant(s) PRICE, CHARLES E.	
	Examiner Paul Marcantoni	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 26, 27, 33, 34, 36, 37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 26, 27, 33, 34, 36, 37, and 39-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's arguments filed 8/8/07 have been fully considered but they are not persuasive.

35 USC 112 First Paragraph- Enablement: (Withdrawn)

This rejection is withdrawn because applicants canceled all claims directed to their compressive strengths. This rejection will be re-applied should applicants re-present these claims containing compressive strengths in this application or a continuing application for the reasons set forth in the previous office action.

Objection to Specification-(Withdrawn):

The objection to the specification is withdrawn because applicants canceled all claims directed to compressive strengths. This objection will be re-applied should applicants re-present these claims containing compressive strengths in this application or a continuing application for the reasons set forth in the previous office action.

New Matter (Withdrawn):

The new matter rejection was withdrawn because applicants removed because applicants removed the new matter limitation from their claims (ie approximately 1.125 gallons of water per cubic foot of cementitious composition to approximately 1.96 gallons per cubic foot of cementitious composition). This rejection will be re-applied should applicants re-present these claims containing compressive strengths in this application or a continuing application for the reasons set forth in the previous office action.

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The remaining rejections are listed below:

35 USC 112 Second Paragraph:

Claims 1, 5, 26, 27, 33, 34, 36, 37, and 39-41 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The terms "first portion" and "second portion" (previously coarse and fine portion respectively, eg claim 1 and others) are indefinite because there is overlap between both particle size portions and it is not possible to distinguish clearly between the two portions in all independent claims or wherever it occurs in applicants' claims.

35 USC 102/103:

Claims 1, 5, 26, 27, 33, 34, 36, 37, and 39-41 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hopkins '075, Nisnevich et al. '751, Shulman '547 B2, Brewer et al. '950 or '261, or Jones '973.

Response:

The examiner maintains that both first portion and second portion particle sizes for bottom ash as claimed by applicants (e.g. see claim 1) overlap and thus it cannot be clarified which particles falls into which portion.

The applicants argue the specific particle distribution and amounts of fly ash for each portion of particle size. Yet, it is the examiner's position that control of particle size would have been an obvious design choice absent a showing of criticality or unexpected results. The examiner finds that this would be difficult to show criticality or unexpected

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results especially considering that claims directed to the property needed to show unexpected results (ie compressive strength) have all been canceled by applicants. Absent this showing, the prima facie case of obviousness has not been overcome.

It is noted that the applicants argue "compressive strength" on page 10 of their response that they obtain a high compressive strength. The examiner maintains that applicants cannot argue this feature because they have not shown that their "claimed" invention have all the features that allow for them to obtain high compressive strengths such as specific particle size, water/cement ratio, specific amounts of Portland cement vs bottom ash, etc. It is improper to argue features not present in their own claims and applicants cannot rely on their disclosure for the deficiency of limitations in their claims. While it is true that the claims may be read in light of the specification, it is improper to read the limitations of the specification into the claims. In re Yamato, 222 USPQ 93; In re Wilson, 149 USPQ 523; Graver Tank v. Linde Air Products Co. 80 USPQ 451 (Supreme Court).

The applicants also argue that the prior art does not teach mixing the first and second portions together. In rebuttal, the prior art teaches an overlap of both applicants first and second portion bottom ash particle size so their would be an mixing together of these portions or particle sizes. Again, applicants fail to distinguish one portion from the other because the portions' particle sizes overlap. Also, applicants have yet to show criticality or unexpected results for their specific particle sizes/portions. The prior art still teaches amounts of bottom ash and cement that do overlap.

The applicants also argue extra additives in the prior art such as silica fume, fly ash, expanded polystyrene, blast furnace slag, other adjuvants, fillers, etc. The applicants are reminded, however, that they use comprising claim language. Comprising leaves the claim open for the inclusion of unspecified ingredients even in major amounts. Ex parte Davis et al., 80 USPQ 448 (PTO Bd of App.1948).

The prior art is not required to teach the exact particle size range of each portion either. The prior art overlaps applicants' ranges and thus meets their claim limitations. Again, even if the particle size were not the same, the applicants have not shown criticality or unexpected results for properties such as compressive strength for their claimed composition.

The applicants' arguments and response has been fully considered but thus found unpersuasive. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
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